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EXAMINER

LOFTIS, JOHNNA RONEE

ART UNIT

PAPER NUMBER

3624

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/870,865	<b>Applicant(s)</b> LINDIA ET AL.	
	<b>Examiner</b> JOHNNA R. LOFTIS	<b>Art Unit</b> 3624	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 17 February 2010.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 10-16 and 19-42 is/are pending in the application.

    4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☒ Claim(s) 10-16, 19-42 is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All    b) ☐ Some \*    c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
    Paper No(s)/Mail Date \_\_\_\_\_.

4) ☐ Interview Summary (PTO-413)  
    Paper No(s)/Mail Date \_\_\_\_\_.

5) ☐ Notice of Informal Patent Application

6) ☐ Other: \_\_\_\_\_.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 2/17/2010 has been entered.
2. Applicant has amended claims 10, 11, 12, 15, 16. Claims 17 and 18 are cancelled. New claims 19-42 have been added. Claims 10-16, and 19-42 are pending and have been examined on the merits set forth below.

***Claim Objections***

3. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

On pages 5-8 of the claim listing, the claims are numbered 23-27 and then 26-40. Please make appropriate corrections upon next response. For purposes of examination, misnumbered claims 26-40 have been renumbered 28-42

***Response to Arguments***

4.       pplicant argues Dirksen's ratee/employee selected reviewers are fundamentally different from the claimed subject matter. Examiner first points out that From MPEP 2111.03: The transitional term "comprising", which is synonymous with "including," "containing," or "characterized by," is inclusive or open-ended and does not exclude additional, unrecited elements or method steps. See, e.g., > Mars Inc. v. H.J. Heinz Co., 377 F.3d 1369, 1376, 71 USPQ2d 1837, 1843 (Fed. Cir. 2004) ("like the term comprising,' the terms containing' and mixture' are open-ended."); < Invitrogen Corp. v. Biocrest Mfg., L.P., 327 F.3d 1364, 1368, 66 USPQ2d 1631, 1634 (Fed. Cir. 2003) ("The transition comprising' in a method claim indicates that the claim is open-ended and allows for additional steps."); Genentech, Inc. v. Chiron Corp., 112 F.3d 495, 501, 42 USPQ2d 1608, 1613 (Fed. Cir. 1997) ("Comprising" is a term of art used in claim language which means that the named elements are essential, but other elements may be added and still form a construct within the scope of the claim.); Moleculon Research Corp. v. CBS, Inc., 793 F.2d 1261, 229 USPQ 805 (Fed. Cir. 1986); In re Baxter, 656 F.2d 679, 686, 210 USPQ 795, 803 (CCPA 1981); Ex parte Davis, 80 USPQ 448, 450 (Bd. App. 1948) ("comprising" leaves "the claim open for the inclusion of unspecified ingredients even in major amounts"). >In Gillette Co. v. Energizer Holdings Inc., 405 F.3d 1367, 1371-73, 74 USPQ2d 1586, 1589-91 (Fed. Cir. 2005), the court held that a claim to "a safety razor blade unit comprising a guard, a cap, and a group of first, second, and third blades" encompasses razors with more than three blades because the transitional phrase "comprising" in the preamble and the phrase "group of" are presumptively open-ended. "The word comprising' transitioning from the preamble to the body signals that the entire claim is presumptively open-ended." In view of this,

while Dirksen may teach more features than what is recited in the claimed invention, examiner asserts Dirksen reads on the invention as claimed.

5. Applicant also argues Dirksen does not teach receiving reviewee selection from the transmitted preloaded list. Examiner respectfully disagrees. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

6. Regarding Applicant's comments about claim 15, Examiner points out that official notice was first asserted in the office action mailed 4/27/05. Based on MPEP section 2144.03C, the official notice statements were never properly traversed in the subsequent response submitted 7/29/05. Thereby the determination has been made that the limitations under official notice are taken as admitted prior art.

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

8. Claims 10-14, 16, 19, 20, 23, 24, 26-28, 30-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Dirksen et al, US 6,853,975.

As per claim 10, Dirksen et al teaches transmitting, by a computer system, a preloaded list of reviewees, wherein the list is generated based on substantial employment related

interaction during a relevant review period of time (column 4, lines 40-64 – based on employee relationships, it is determined who should rate whom; further the list of reviewees is preloaded since the rater must access the system and select the reviewee name from the system); receiving one or more reviewee selection from the transmitted preloaded list whose employment performance a user desires to review (column 4, lines 55 – 61 – the users initiate the rating process and select the name of the person they want to rate; when the user is notified that they have been requested to review another person, there is no indication that that person is obligated or required to do so); updating employee performance review information on the selected reviewees received by the computer system (column 4, line 62 – column 5 – the ratings information is input into the system by the user); processing the updated employee performance review information on the selected reviewees (column 5, lines 1-25 – the information is processed for report preparation); storing the processed employee performance review information (column 5, lines 1-25 – the rating data is stored and submitted to an external company for processing); and generating by the computer system an overall performance summary of the selected reviewees based on the stored performance reviews (column 5, lines 1-25 – performance ratings displayed).

As per claim 11, Dirksen et al teaches receiving one or more reviewer selection from the user, wherein the selected reviewers include at least one of the user, a superior, a peer, a subordinate and a client (column 1, lines 50-53 - the user selects a group of raters who will complete the ratings process; column 2, line 66 – column 3, line 2 – raters include managers and work partners).

As per claim 12, Dirksen et al teaches updating further comprises updating of said employee performance review information over a communication network (column 3, lines 25-30 – the evaluation information is transmitted over a network and column 5).

As per claim 13, Dirksen et al teaches the communication network is in the Internet (column 3, lines 25-30 – teaches the Internet).

As per claim 14, Dirksen et al teaches the communication network is a business enterprise intranet (column 3, lines 33-37 – the intranet is used for access to the rating system).

As per claim 16, Dirksen et al teaches requiring manager approval of the selected reviewees prior to the updating, processing and storage of the employee performance review information (column 3, lines 8-25 – the user submits a list of raters for approval by the manager, upon approval/disapproval, the list is stored on an internal file; when the user proceeds to the performance rating step, inherently the persons the user is rating have been approved since they are listed for selection).

As per claim 19, teaches identifying by a computer system one or more interactions during an evaluation period between a reviewer and one or more reviewees based on overlapping projects and clients (column 3, lines 1-3 – reviewers include managers and work partners); preloading by the computer system a list of the reviewees related to the identified interactions (column 4, lines 60-61 – rater must select from list of reviewees, therefore list is preloaded); receiving by the computer system a selection of reviewees from the preloaded list (column 4, lines 60-61 – rater must select from list of reviewees, therefore list is preloaded); receiving by the computer system one or more performance reviews on the selected reviewees (column 4, line

62 - column 5 – the ratings information is input into the system by the user); processing by the computer system the received performance reviews (column 5, lines 1-25 – the information is processed for report preparation); and generating by the computer system an overall performance summary of the reviewees based on the processed performance reviews (column 5, lines 1-25 – performance ratings displayed).

As per claim 20, Dirksen teaches each performance review includes performance ratings relative to expectations for each reviewee's peer group (column 4, lines 62-65).

As per claim 23, Dirksen teaches receiving from the user a request to a manager for approval of the selected reviewees; and receiving from the manager a message approving the selected reviewees for performance reviews (column 3, lines 8-25 – the user submits a list of raters for approval by the manager, upon approval/disapproval, the list is stored on an internal file; when the user proceeds to the performance rating step, inherently the persons the user is rating have been approved since they are listed for selection).

As per claim 24, Dirksen teaches storing data related to the processed performance reviews (column 4, line 62 – column 5, line 17).

As per claim 26, Dirksen teaches updating the preloaded list of the reviewees by adding a list of reviewers related to the identified interactions (column 3, lines 1-3 – reviewers include managers and work partners).

As per claims 28-33, they are directed to the system for performing the method in claims 10-12 and 16. Therefore, the same art and rationale apply.

Claims 34-42 are directed to the system for performing the method in claims 19-27. Therefore, the same art and rationale apply.



***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dirksen et al, US 6,853,975.

As per claim 15, Dirksen et al does not explicitly teach inputting said employee performance review information by the user while the disconnected from the communication network. However, it is old and well known in the art of communication networks to allow for work to be complete while disconnected from the Internet wherein the information can be stored and communicated over a network when there is a network connection present. This feature allows for convenience to the operator wherein he or she can complete the rating while away from the office.

9. Claims 21, 22, 25 and 29 rejected under 35 U.S.C. 103(a) as being unpatentable over Dirksen, US 6853975, in view of Ibarra, US 6119097.

As per claim 21, Dirksen teaches generating and processing reviews, but does not teach the processing further comprises indentifying trends in each reviewee's job performance in comparison with the reviewee's prior performance reviews. Ibarra teaches identifying trends in each reviewee's performance (column 2, line 66 – column 3, line 7). It would have been obvious

to one of ordinary skill in the art at the time of the invention to include in the system of Dirksen the ability to identify trends as taught by Ibarra since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 22, Dirksen teaches performing reviews, but does not explicitly teach each performance review includes an action item for each reviewee to follow up on. Ibarra teaches determining action steps based on review. Action steps are agreed upon and to be taken by the employee to ensure standards are met in the future (column 6, line 61 – column 7, line 7). It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Dirksen the ability to indicating action items for follow up as taught by Ibarra since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 25, Dirksen does not explicitly teach receiving one or more non-preloaded reviewees relating to one or more interactions identified by the user. Ibarra teaches setup of a new employee wherein the new employee is added to the system (column 10, lines 41-50). It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Dirksen the ability to enter information for a new employee (who is inherently not preloaded into the system) as taught by Ibarra since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed

the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim 29, Dirksen does not explicitly teach the identification of the non-preloaded reviewees relating to one or more interactions further comprises searching by the user an employee roster using a plurality of search criteria. Ibarra teaches setup of a new employee wherein the new employee is added to the system (column 10, lines 41-50). Once the employee is in the system, the user may browse the system to retrieve the name of an employee who works under a manager (column 6, lines 27-39). It would have been obvious to one of ordinary skill in the art at the time of the invention to include in the system of Dirksen the ability to search for a non-preloaded employee as taught by Ibarra since the claimed invention is merely a combination of old elements and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3624

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Johnna R Loftis/  
Examiner, Art Unit 3624